

UTILITY MODEL ACT

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CHAPTER I

GENERAL PROVISIONS

Article 1 Purpose

The purpose of this Act is to encourage, protect and utilize practical devices, thereby improving and developing technology, and to contribute to the development of industry.

Article 2 Definitions

The definitions of terms used in this Act are as follows:

- (i) "device" means the creation of technical ideas using the rules of nature;
- (ii) "registered utility model" means a device for which a utility model has been granted; and
- (iii) "working" means acts of manufacturing, using, assigning, leasing, importing, or offering for assignment or lease (including displaying for assignment or lease) an article to which a device has been applied.

Article 3 Invalidity of Procedure

(1) Where a person who has been instructed to make an amendment under Article 11 fails to do so within a designated period, the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal may invalidate an application, request for a motion and other utility model-related procedures (referred to as "a utility model-related procedure").

(2) Where a utility model-related procedure is invalidated under paragraph (1), if the delay is considered to have been caused by unavoidable reasons, the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal may revoke the disposition of invalidation at the request of the person instructed to make the amendment, provided the request is made within fourteen days of the date on which the reasons for the delay cease to exist and not more than a year after the designated period expired.

Article 3*bis* Scope of Powers of Attorneys

Unless expressly empowered, a representative instructed to initiate a utility model-related procedure before the Korean Intellectual Property Office by a person whose residential or business address is in the Republic of Korea may not abandon or withdraw an application for a utility model, withdraw a petition or a request for a motion, make or withdraw a priority claim under Article 18(1), abandon a utility model right, request a trial or appoint a sub-representative under Articles 54 and 54*bis*.

Article 3*ter* Representation of Two or More Persons

(1) Where two or more persons jointly initiate a utility model-related procedure, each of them may represent the joint initiators, except in any of the following actions, unless the joint initiators have appointed a common representative and have notified the Korean Intellectual Property Office or the Intellectual Property Tribunal of the appointment of the representative:

- (i) abandonment or withdrawal of a utility model application;
- (ii) claim or withdrawal of a priority claim under Article 18(1);
- (iii) withdrawal of a petition or a request; and
- (iv) request for a trial under Article 54 or 54*bis*.

(2) Where a common representative has been appointed and notification has been given under paragraph (1), written proof that the representative has been appointed must be presented.

Article 4 *Mutatis Mutandis* Application of the Patent Act

Articles 3 to 5, 7 to 10, 12 to 15 and 17 to 28 *quinquies* of the Patent Act apply *mutatis mutandis* to utility models. In such an operation, a person who requests an examination of a patent application under Article 4 of the Patent Act is deemed a person who requests a technical evaluation of a utility model application.

CHAPTER II

REQUIREMENTS FOR UTILITY MODEL REGISTRATION AND UTILITY MODEL APPLICATIONS

Article 5 Requirements for Utility Model Registration

(1) A utility model may be granted for devices that are industrially applicable and relate to the shape or structure of an article or a combination of articles, unless they fall under either of the following subparagraphs:

- (i) devices publicly known or worked in the Republic of Korea before the filing of the utility model application; or
- (ii) devices described in a publication distributed in the Republic of Korea or in a foreign country before the filing of the utility model application or made available to the public through electronic telecommunication lines under Presidential Decree.

(2) Notwithstanding paragraph (1), where a device could easily have been

made before the filing of the utility model application by a person with ordinary skill in the art to which the device pertains, on the basis of a device referred to in either subparagraph of paragraph(1), a utility model registration may not be granted to that device.

(3) Notwithstanding paragraph (1), where a device for which a utility model application is filed is identical to a device or an invention described in the description or drawing(s) originally attached to another utility model application or a patent application, and where the other utility model application was filed before the utility model application and published after registration for public inspection after the filing date of the utility model application, or where a patent application was filed before the utility model application and laid open or published after grant for public inspection after the filing date of the utility model application, a utility model may not be granted for the device of the utility model application. This provision does not apply, however, where the inventor of the utility model application and the inventor of the other utility model or patent application are the same person or where the applicant of the utility model application and the applicant of the other utility model or patent application are the same person at the time of filing.

(4) Where the other utility model or patent application under paragraph (3) is an international application deemed to be a utility model application under Article 57(1) of this Act, or an international application deemed to be a patent application under Article 199(1) of the Patent Act (including an international application considered to be a utility model or patent application under Article 71(4) of this Act or a patent application under Article 214(4) of the Patent Act), in applying paragraph(3), "laid open" reads "laid open or the subject of an international publication under Article 21 of the Patent Cooperation Treaty," and "a device or an invention described in the description or drawing(s) originally attached" reads "a device or an invention described both in the description, claim(s) or drawing(s) of the international application as of the international filing date and in the translated version".

Article 6 Devices Deemed to be Not Known etc.

(1) Where a device that belongs to a person with the right to obtain a utility

model registration falls under any of the following subparagraphs, the device is not considered to fall under either subparagraph of Article 5(1) where Article 5(1) or (2) applies if the utility model application is filed within six months of the applicable date:

- (i) where a person with the right to obtain a utility model registration causes the device to fall under either subparagraph of Article 5(1) by performing any of the following acts:
 - (a) an experiment
 - (b) publication of the device in printed matter;
 - (c) publication through electric telecommunication lines under Presidential Decree;
 - (d) presentation in writing at an academic organization by ordinance of the Ministry of Commerce, Industry and Energy.
- (ii) where the device falls under either subparagraph of Article 5(1) against the intention of the person with the right to obtain a utility model registration;
- (iii) where a person with the right to obtain a utility model registration causes the device to fall under either subparagraph of Article 5(1) by displaying the device at an exhibition.

(2) A person taking advantage of paragraph (1)(i) or (1)(iii) shall submit, simultaneously with a utility model application, a written statement to that effect to the Commissioner of the Korean Intellectual Property Office, to whom the person shall also submit, within thirty days of the filing date of the utility model application, a document proving the relevant facts.

Article 7 Unregistrable Devices

Notwithstanding Article 5(1) and (2), devices falling under either of the following subparagraphs are unregistrable:

- (i) devices that are identical or similar to the national flag or decorations; or

- (ii) devices liable to contravene public order or morality, or to injure public health.

Article 8 First-to-File Rule

(1) Where two or more applications related to the same device are filed on different dates, only the applicant with the earlier filing date may obtain a utility model registration for the device.

(2) Where two or more applications related to the same device are filed on the same date, only the person agreed upon by all the applicants after consultation may obtain a utility model registration for the device. If no agreement is reached or no consultation is possible, none of the applicants may obtain a utility model registration for the device.

(3) Where a utility model application has the same subject matter as a patent application and the applications are filed on different dates, the applicant of the utility model application may obtain a utility model registration for the device only if the utility model application has the earlier filing date.

(4) Where a utility model application has the same subject matter as a patent application and the applications are filed on the same date, a utility model application may be registered only if an agreement is reached between the utility model applicant and the patent applicant that only the utility model application would be registered. This provision does not, however, apply to a utility model application (including a utility model application deemed to have been filed on the same date as the patent application under Article 17(3)) that is filed on the same date as the patent application if the utility model application is a dual application under Article 17.

(5) Where a utility model application or a patent application is invalidated, withdrawn or a utility model application is rejected, the application, for the purposes of paragraphs (1) to (4), is deemed never to have been filed.

(6) A utility model application or patent application filed by a person who is not the deviser, inventor or successor in title to the right to obtain a utility model registration or a patent, for the purposes of paragraphs (1) to (4), is deemed never to have been filed.

Article 9 Application for a Utility Model Registration

(1) A person seeking to register a utility model shall file a utility model application with the Commissioner of the Korean Intellectual Property Office, stating the following:

- (i) the name and address of the applicant (and, if a legal entity, the name and address of the business);
- (ii) the name and residential or business address of an agent, if any (and, if the agent is a patent legal entity, the name and address of the business and the name of the designated patent attorney);
- (iii) deleted;
- (iv) the title of the device;
- (v) the name and address of the deviser; and
- (vi) deleted.

(2) A utility model application under paragraph (1) must be accompanied by an abstract, drawing(s) and a description stating the following:

- (i) the title of the device;
- (ii) a brief explanation of the drawing(s);
- (iii) a detailed description of the device; and
- (iv) the claim(s).

(3) The detailed description of the device under paragraph (2)(iii) must state the purpose, construction and effect of the device in such a manner that it may easily be carried out by a person with ordinary skill in the art to which the device pertains.

(4) The claim(s) under paragraph (2)(iv) must describe the matter for which protection is sought in one or more claims (referred to as "claim(s)"), and the

claim(s) must comply with each of the following subparagraphs:

- (i) the claim(s) must be supported by a detailed description of the device;
- (ii) the claim(s) must define the device clearly and concisely; and
- (iii) the claim(s) must define only the features indispensable for the constitution of the device.

(5) Details concerning the drafting of claim(s) under paragraph(2)(iv) are prescribed by Presidential Decree.

(6) Details concerning the description of an abstract under paragraph(2) are prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

Article 10 Scope of a Utility Model Application

(1) A utility model application must relate to a single device only, unless a group of devices is linked to form a single general device concept.

(2) The requirements for a utility model application under paragraph (1) are prescribed by Presidential Decree.

Article 11 Amendment of Procedure

The Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal shall order amendments to a utility model-related procedure within a designated period if the procedure falls under any of the following subparagraphs:

- (i) where the procedure does not comply with Article 3(1) of the Patent Act as applied *mutatis mutandis* under Articles 3*bis* or 4 of this Act;
- (ii) where the procedure does not comply with the formalities prescribed in this Act or by Presidential Decree;

- (iii) where, in violation of Article 29(2) of this Act, registration fees for the first year have not been paid; or
- (iv) where fees required under Article 30 have not been paid.

Article 12 Examination of Basic Requirement and Rejection of an Application

(1) The Commissioner of the Korean Intellectual Property Office shall have a utility model application examined by an examiner to determine whether it falls any of the following subparagraphs:

- (i) where the device in the utility model application is related to the shape or structure of an article or a combination of articles;
- (ii) where the device in the utility model application is registrable under Article 7 of this Act;
- (iii) where the utility model application is drafted in accordance with Article 9(5) of this Act or meets the requirements of Article 10 of this Act;
- (iv) where the description or drawing(s) attached to the utility model application contain essential elements and are substantially clear; or
- (v) where an amendment to the description or drawing(s) attached to the utility model application complies with Article 14.

(2) An examiner may order an amendment to the description and drawing(s) attached to a utility model application within a designated period under any of the following subparagraphs:

- (i) where the device in the utility model application is not related to the shape or structure of an article or a combination of articles;
- (ii) where the device in the utility model application is unregistrable under Article 7 of this Act;

- (iii) where the utility model application does not comply with Article 9(5) of this Act or does not meet the requirements of Article (10) of this Act;
 - (iv) where the description or drawing(s) attached to the utility model application do not contain essential elements or are substantially unclear; or
 - (v) where the amendment of the description or drawing(s) attached to the utility model application does not comply with Article 14.
- (3) Where a person who has been instructed to make an amendment under paragraph (2) fails to do so within the designated period, the examiner shall reject the utility model application; the decision to reject must be in writing and must state the reasons for the decision.

Article 13 Amendment of a Utility Model Application etc.

(1) A person who initiates an application for utility model-related procedures may amend the application only when the utility model application is pending in the Intellectual Property Office or the Intellectual Property Tribunal. However, the description, drawing(s) and the abstract attached to the utility model application may not be amended after a period designated by ordinance of the Ministry of Commerce, Industry and Energy after the filing date of the utility model application.

(2) Deleted.

Article 14 Scope of an Amendment to Descriptions etc.

An amendment to the description or drawing(s) under Articles 12(2) and 13 of this Act must be within the scope of the features disclosed in the description or drawing(s) originally attached to a utility model application.

Article 15 Treatment of Amendments to a Dual Application etc.

(1) Deleted.

(2) Where a dual application under Article 17 of this Act is determined to have escaped from the scope of the claim(s) originally attached to a patent application after the registration of the utility model right, the dual application is deemed to have been filed when the written dual application was submitted.

Article 16 Division of Utility Model Application

(1) An applicant who has filed a utility model application comprising two or more devices may divide the application into two or more applications within the period prescribed in Article 12(2) and the proviso of Article 13(1) of this Act.

(2) A divided utility model application under paragraph (1) (referred to as "a divisional application") is deemed to have been filed at the time the original utility model application was filed. However, the divisional application is deemed to have been filed on the date it was submitted if any of the following subparagraphs applies:

- (i) where Article 5(3) of this Act or Article 29(3) of the Patent Act applies, when a divisional application falls under another utility model application prescribed in Article 5(3) of this Act or a utility model application prescribed in Article 29(3) of the Patent Act;
- (ii) where Article 6(2) of this Act applies;
- (iii) where Article 18(2) of this Act applies; or
- (iv) where Article 54(3) of the Patent Act as applied *mutatis mutandis* under Article 20 of this Act applies.

(3) A person who files a divisional application under paragraph (1) shall indicate the purpose of the divisional application and the utility model application that forms the basis of the division.

(4) A person claiming the right of priority for a divisional application under Article 54 of the Patent Act, as applied *mutatis mutandis* under Article 20 of this Act, may file the documents as prescribed in Article 54(4) of the Patent Act with the Commissioner of the Korean Intellectual Property Office within three months after filing the divisional application, regardless of the period prescribed in Article 54(4) of the Patent Act.

Article 17 Dual Application

(1) A person who has filed a patent application may file a utility model application that is within the scope of the original description attached to the patent application (referred to as 'a dual application'), if the utility model application is filed before the receipt of a certified copy of the decision to grant a patent under Article 66 of the Patent Act. However, this provision does not apply if more than 30 days (or the extended period when a period for demanding a trial against a decision of refusal under Article 132^{ter} of the Patent Act is extended under Article 15(1) of the Patent Act as applied *mutatis mutandis* under Article 4 of this Act) have elapsed following the transmittal of the examiner's first decision to reject the patent application.

(2) A person who initiates a dual application under paragraph (1) shall indicate its purpose and the patent application that forms the basis of the dual application.

(3) Where a dual application is carried out under paragraph (1), the utility model application is deemed to have been filed on the date the patent application was filed. However, if any of the following subparagraphs apply, the utility model application is deemed to have been filed on the date the dual application was submitted:

- (i) where Article 5(3) of this Act or Article 29(3) of the Patent Act applies, when the utility model application falls under another utility model application under Article 5(3) of this Act or a utility model application under Article 29(3) of the Patent Act;
- (ii) where Article 6(2) of this Act applies;

- (iii) where Article 18(2) of this Act applies;
- (iv) where Article 54(3) of the Patent Act as applied *mutatis mutandis* under Article 20 of this Act applies.

(4) Notwithstanding Article 54(4) of the Patent Act, a person claiming the right of priority for a utility model application under paragraph(1) of this Article may file documents as prescribed in Article 54 of the Patent Act as applied *mutatis mutandis* under Article 20 of this Act to the Commissioner of the Korean Intellectual Property Office within three months of filing the dual application.

Article 18 Priority Claim Based on a Utility Model Application etc.

(1) A person seeking to register a utility model may claim the right of priority for a device claimed in a utility model application disclosed in the description or drawing(s) originally attached to a utility model application or patent application for which the person has the right to obtain a patent or utility model registration (referred to as "an earlier application"), which the person filed before the later utility model application, except under any of the following circumstances:

- (i) where the later utility model application is filed more than one year after the filing date of the earlier application;
- (ii) where the earlier application falls under any of the following subparagraphs:
 - (a) a divisional application under Article 16(1) of this Act;
 - (b) a dual application under Article 17 of this Act;
 - (c) a divisional application under Article 52(1) of the Patent Act;
 - (d) a dual application under Article 53 of the Patent Act.
- (iii) where the earlier application has been abandoned, invalidated, withdrawn or rejected when the later utility model application is filed;

- (iv) where an examiner's decision on the grant of a patent or a trial or appeal decision rejecting the earlier application has become final when the later utility model application is filed; or
- (v) where the earlier application has been registered under Article 35(2) of this Act when the later utility model application is filed.

(2) A person claiming the right of priority under paragraph (1) shall indicate the purpose of the claim when filing the utility model application and identify the earlier application in the utility model application.

(3) A person who meets the requirements for claiming priority claim under paragraph (1) may amend or add the right of priority within one year and four months of the filing date of the earlier application (or, for two or more earlier applications, the filing date of the earliest application).

(4) Where devices described in a utility model application that claims the right of priority under paragraph (1) are disclosed in the description or drawing(s) originally attached to an earlier application that is the basis for the priority claim (excluding those devices disclosed in an application that claims priority to an earlier application that also claims priority under paragraph (1) of this Article or that claims priority under Article 4D(1) of the Paris Convention for the Protection of Industrial Property), the utility model application is deemed to have been filed when the earlier application was filed for the purpose of the following: Articles 5(1), (2) and (3) (main sentence), 6(1), 8(1) to (4), 38(iii), 39 and 41(1) and (2) of this Act, Article 136(4) of the Patent Act as applied under Article 77(3) of the Patent Act as applied *mutatis mutandis* under Article 42 of this Act, Article 103 of the Patent Act as applied *mutatis mutandis* under Article 42 of this Act; Articles 36(3) and 98 of the Patent Act and Articles 45 and 52(3) of the Industrial Design Act.

(5) For devices described in the description or drawing(s) originally attached to a utility model application that claims priority under paragraph (1) and disclosed in the description or drawing(s) originally attached to the earlier application that is the basis for the priority claim (excluding those devices disclosed in an application that claims priority to an earlier application that also claims priority under paragraph (1) of this Article or that claims priority

under Article 4D(1) of the Paris Convention for the Protection of Industrial Property), the laying open or publication for public inspection of the earlier application is deemed as effected at the time of laying open after registration of the utility model right was effected under Article 5(3) of this Act or Article 29(3) of the Patent Act. For this paragraph, "the earlier application" is deemed to be an international application deemed to be a utility model application under Article 57(1) of this Act or an international application deemed to be a patent application under Article 199(1) of the Patent Act (including an international application considered to be a utility model application or a patent application under Article 71(4) of this Act or Article 214(4) of the Patent Act); and "a device or invention described in the description, claim(s) or drawing(s) of the international application as of the international filing date and in the translated version" in Article 5(4) of this Act reads "a device or invention described in the description, claim(s) or drawing(s) of the international application as of the international filing date".

Article 19 Withdrawal of an Earlier Application etc.

(1) An earlier application from which the right of priority is claimed under Article 18(1) is deemed withdrawn one year and three months after the filing date of the earlier application where the application is a patent application, or from the claimed priority date of the earlier application where the application is a utility model application unless the earlier application falls under any of the following subparagraphs:

- (i) where it has been abandoned, withdrawn, invalidated or rejected;
- (ii) where an examiner's decision on the grant of a patent, or a trial or an appellate trial decision, has become final;
- (iii) where priority claims based on the earlier application have been withdrawn; or
- (iv) where the earlier application has been registered under Article 35(2) of this Act.

(2) The applicant of a utility model application that contains a priority claim under Article 18(1) may not withdraw the priority claim more than one year and three months after the filing date of the earlier application.

(3) Where a utility model application containing a priority claim under Article 18(1) is withdrawn within one year and three months of the filing date of an earlier application, the priority claim is deemed to be withdrawn simultaneously.

Article 20 *Mutatis Mutandis* Application of the Patent Act

(1) Articles 33, 37 to 41, 43 and 44 of the Patent Act apply *mutatis mutandis* to the requirements for utility model registration and utility model applications.

(2) Article 35 of the Patent Act applies *mutatis mutandis* to utility model applications. In such cases, "for lack of entitlement to obtain a patent under Article 33(1)" reads "for lack of entitlement to obtain a patent under Article 33(1) of the Patent Act as applied *mutatis mutandis* under Article 20 of this Act in Article 25(1)(ii) or Article 47(1)(ii)".

(3) Article 54 of the Patent Act applies *mutatis mutandis* to claiming priority by Treaty for utility model applications. In such cases, "a person who ... complies with the requirements of paragraph(2)" in Article 54(7) reads "before a person who complies with the requirements of paragraph(2) obtains registration under Article 35(1)", and "within one year and four months of the earliest date" reads "within one year and four months of the earliest date and before registration under Article 35(1)".

CHAPTER III

TECHNICAL EVALUATION

Article 21 Request for Technical Evaluation of Utility Models

(1) Any person may request a technical evaluation of registered utility model to the Commissioner of the Korean Intellectual Property Office. Where the claims of registered utility model contains two or more claims, a request must be made for all claims.

(2) A request under paragraph (1) may be made even after the extinguishment of a utility model right. However, where a utility model registration is revoked by a decision to revoke under Article 74(3) of the Patent Act as applied *mutatis mutandis* under Article 48 of this Act, or invalidated by an invalidation trial under Article 49(1) of this Act, this provision does not apply.

(3) A request under paragraph (1) may not be withdrawn.

(4) A request under paragraph (1) may be made only once. However, if an examiner cannot determine whether the utility model registration violates Articles 5(3) and (4) or 8(1) to (4) under the proviso of Article 25(2), an additional request may be made only once when the reason ceases to exist.

(5) Requisite procedures for a request for a technical evaluation of a utility model are prescribed by Presidential Decree.

Article 22 Technical Evaluation by Examiner

(1) When a request under Article 21(1) of this Act has been submitted, the Commissioner of the Korean Intellectual Property Office shall appoint an examiner to technically evaluate the utility model.

(2) Article 57(2) of the Patent Act applies *mutatis mutandis* to the qualification of examiners.

Article 23 Publication of Request for Technical Evaluation

(1) When a request for a technical evaluation of a utility model application has been made before publication of the utility model registration, the Commissioner of the Korean Intellectual Property Office shall publish the request in the Utility Model Gazette simultaneously with the publication of the registration.

(2) When a request for a technical evaluation of a registered utility model is made after publication of the registration, the Commissioner of the Korean Intellectual Property Office shall immediately publish the request in the Utility Model Gazette.

(3) Where a request for a technical evaluation has been made by a person other than the owner of a utility model right, the Commissioner of the Korean Intellectual Property Office shall notify the owner of the utility model right of the request.

Article 24 Prior Art Searches etc.

(1) Where a specialized search organization for searching prior art documents is considered necessary for the technical evaluation of a utility model, the Commissioner of the Korean Intellectual Property Office may rely on such an organization.

(2) Articles 58(2) and 58*bis* of the Patent Act apply *mutatis mutandis* to a technical evaluation of a utility model.

(3) Requisite matters concerning an assignment, such as the criteria of an assignment for a specialized search organization and the procedures for searching documents under paragraph(1), are prescribed by Presidential Decree.

Article 25 Decision on Request for Technical Evaluation

(1) An examiner shall revoke a utility model registration (referred to as 'a

decision to revoke a utility model registration"), if any of the following conditions apply in view of the results of a technical evaluation:

- (i) the utility model registration violates Article 25 of the Patent Act as applied *mutatis mutandis* under Article 4 of this Act, Articles 5, 7, 8(1) to (4) and 9(3) and (4) of this Act or Article 44 of the Patent Act as applied *mutatis mutandis* under Article 20 of this Act;
- (ii) where a person is not entitled to a patent under Article 33(1) of the Patent Act, as applied *mutatis mutandis* under Article 20 of this Act, or where a patent may not be granted under the proviso of Article 33(1);
- (iii) the utility model registration violates a treaty; or
- (iv) after registration of a utility model, the owner of the utility model right becomes incapable of enjoying the utility model right under Article 25 of the Patent Act as applied *mutatis mutandis* under Article 4 of this Act, or the utility model right no longer complies with a treaty.
- (v) the utility model registration violates the proviso of Article 35(2).
- (vi) where the amendment is beyond the scope of Article 14.

(2) If the utility model registration does not fall under any subparagraph of paragraph(1) in view of the results of a technical evaluation, an examiner shall decide to maintain the utility model registration (referred to as "a decision to maintain a utility model registration"). An examiner who cannot determine whether the utility model registration violates Articles 5(3) and (4) or 8(1) to (4) shall state such decision and the reasons for the decision.

(3) When revoking a utility model registration under paragraph(1), an examiner shall notify the requester of the technical evaluation and the owner of the utility model right of the reasons for revocation (only when the requester of the technical evaluation and the owner of the utility model right is not the same person), and provide the requester and owner with an opportunity to submit a written statement of arguments within a designated period.

(4) Where a decision to revoke a utility model registration under paragraph(1) has become final, the utility model right is deemed never to have existed. However, if a decision to revoke a utility model registration under Article 25(1)(iv) has become final, the utility model right is deemed not to have existed at the time the utility model registration first became subject to paragraph (1)(iv).

(5) An appeal may not be made against the decision to maintain a utility model registration under paragraph (2).

Article 26 Manner of Deciding on a Request for a Technical Evaluation

(1) An examiner's decision on a request for a technical evaluation must be in writing and must state the reasons for the decision.

(2) When an examiner's decision under paragraph(1) has been made, the Commissioner of the Korean Intellectual Property Office shall transmit a certified copy of the decision to the requester of the technical evaluation and the owner of the utility model right.

Article 27 Correction of Utility Model Registration in Technical Evaluation Proceedings

(1) The owner of a utility model right may request in writing a correction of the description or drawing(s) of a registered utility model within the period designated under Article 25(3) of this Act.

(2) A request for a correction under paragraph(1) may be made only for the following reasons:

- (i) to narrow a claim;
- (ii) to correct a clerical error; or
- (iii) to clarify an ambiguous description.

(3) Where a person other than the owner of a utility model right requests a correction under paragraph (1), the examiner shall transmit a copy of the written request to the requester of a technical evaluation.

(4) Article 77(3) of the Patent Act applies *mutatis mutandis* to corrections to a utility model registration.

(5) When a decision is made on the correction of a description or drawing(s) or both, the Commissioner of the Korean Intellectual Property Office shall publish the contents of the correction in the Utility Model Gazette.

Article 28 Suspension of Technical Evaluation Proceedings

(1) Proceedings for a technical evaluation may be suspended, if necessary, until a decision on an opposition against a utility model registration, or a trial decision or trial proceeding, becomes final.

(2) A presiding court may, if necessary, suspend a litigation proceeding until a decision on a technical evaluation becomes final.

(1) An appeal may not be made against the suspension under paragraphs (1) and (2).

Article 28bis *Mutatis Mutandis* Application of the Patent Act

Articles 142, 148(i) to (v) and (vii) of the Patent Act apply *mutatis mutandis* to technical evaluations of utility models.

CHAPTER IV

REGISTRATION FEES AND UTILITY MODEL REGISTRATION ETC.

Article 29 Registration Fees

- (1) The owner of a utility model right or a person seeking to register a utility model right under Article 35(1) shall pay the registration fees.
- (2) Registration fees for the first year of registration under paragraph (1) must be paid simultaneously with a utility model application (or a divisional application for a division under Article 16 of this Act or a dual application for a co-filing under Article 17 of this Act).
- (3) Matters necessary for paying registration fees, including the method and period of payment under paragraph(1), are prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

Article 29bis Late Payment of Registration Fees

- (1) The owner of a utility model right has a period of six months after the expiry of the payment period as prescribed under Article 29(3) to pay the registration fees.
- (2) Where registration fees are paid late under paragraph(1), an amount equivalent to twice the registration fees must be paid.
- (3) Where the owner of a utility model right fails to pay the registration fees within the period of late payment under paragraph(1) (or an owner who fails to pay the remaining portion within the period of remaining payment when the period of remaining payment under Article 29ter(2) has not expired although the period of late payment has expired), the utility model right is deemed to have been extinguished retroactively from the expiry date of the period for paying the registration fees.

Article 29^{ter} Remaining Payment of Registration Fees

- (1) Where the owner of a utility model right fails to pay any portion of the registration fees within the period designated under Articles 29(3) or 29^{bis}(1), the Commissioner of the Korean Intellectual Property Office shall order the owner to pay the remaining balance.
- (2) A person who has been ordered to pay the remaining balance under paragraph (1) has a period of one month after the date of receiving the order in which to pay the remaining balance.
- (3) Where payment of the remaining portion falls under either of the following subparagraphs, a person who pays the remaining portion under paragraph (2) shall pay an amount equivalent to twice the remaining balance:
 - (i) where the remaining portion of the registration fees is paid after the expiry of the payment period under Article 29(3);
 - (ii) where the remaining portion of the registration fees is paid after the expiry of the period for late payment under Article 29^{bis}(1).

Article 29^{quater} Restoration etc. of a Utility Model Right by Late Payment or Remaining Payment of the Registration Fees

- (1) Where the owner of a utility model right fails to pay the registration fees within the period for late payment under Article 29^{bis}(1) or fails to pay the remaining portion within the period for remaining payment under Article 29^{ter}(2) for unavoidable reasons, the owner may pay the registration fees or the remaining registration fees within fourteen days of the date on which the reasons for the delay cease to exist. However, this provision does not apply if six months have elapsed since the expiry date of the period of late payment or the period for remaining payment, whichever comes later.
- (2) Where the late payment or remaining payment of the registration fees is made under paragraph 1, the right of the utility model is deemed

to have existed retroactively when the period for paying the registration fees under Article 29(3) expired.

(3) The effects of a utility model right under paragraph (2) do not extend to the act of working the utility model by other persons from the date on which the period for paying the registration fees expired to the date of payment or remaining payment (referred to in this Article as "the period of limited effect").

(4) During the period of limited effect, a person who has in good faith, under the utility model right prescribed in paragraph (2), commercially or industrially worked or prepared to work a device claimed in the utility model application is entitled to have a nonexclusive license for the utility model right for the device claimed in the utility model application within the scope of the device and the purpose of the business for which the utility model invention is being worked or being prepared to be worked.

(5) A person granted a nonexclusive license under paragraph (4) shall pay reasonable remuneration to the owner of the utility model right or exclusive license.

Article 30 Official Fees

(1) A person initiating a utility model-related procedure registration or requesting a technical evaluation for a utility model shall pay official fees.

(2) Matters necessary for paying official fees, including the method and period of payment under paragraph(1), are prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

Article 31 Refund of Registration Fees etc.

(1) Registration fees and official fees that have been paid may not be refunded, except in the following cases when requested by the person who paid them:

- (i) registration fees or official fees paid by mistake;
- (ii) portions corresponding to the registration fees for years subsequent to the year in which a decision to revoke a utility model registration has become final under Article 25(1) of this Act or Article 74(3) of the Patent Act as applied *mutatis mutandis* under Article 48 of this Act, or a decision to invalidate a utility model registration has become final;
- (iii) registration fees paid for a utility model application that has been invalidated under Article 3(1) of this Act; or
- (iv) registration fees paid for a utility model application that has been dismissed under Article 12(3).

(2) Where a person pays registration fees or official fees by mistake, the Commissioner of the Korean Intellectual Property Office shall notify the person of the mistake.

(3) A refund of the registration fees and official fees under subparagraph (1)(i) may not be claimed where one year has elapsed from the date of being notified that payment was made by mistake; and the refund of the portions corresponding to registration fees under subparagraphs (1)(ii) and (iii) may not be claimed after one year has elapse from the date on which a decision to invalidate or revoke a utility model registration becomes final.

Article 32 Utility Model Register

(1) The Commissioner of the Korean Intellectual Property Office shall maintain a Utility Model Register at the Korean Intellectual Property Office and register the following matters:

- (i) the establishment, transfer, extinguishment, restoration or restriction on the disposal of a utility model right;
- (ii) the establishment, maintenance, transfer, modification, extinguishment or restriction on the disposal of an exclusive or nonexclusive license;

(iii) the establishment, transfer, extinguishment or restriction on the disposal of a pledge on a utility model right or on an exclusive or nonexclusive license; and

(iv) matters equivalent to those stated in subparagraphs (1)(i) to (iii) as prescribed by Presidential Decree.

(2) All or parts of the Utility Model Register under paragraph (1) may be stored on magnetic tapes and so on.

(3) The description and drawing(s) of registered utility models and other documents prescribed by Presidential Decree are considered to be part of the Utility Model Register.

(4) Necessary matters related to the procedures of registration and the maintenance of the register are prescribed by Presidential Decree.

Article 33 Issuance of a Utility Model Registration Certificate

(1) When the establishment of a utility model right has been registered, the Commissioner of the Korean Intellectual Property Office shall issue a utility model registration certificate to the owner of the utility model right.

(2) When the utility model registration certificate does not coincide with the Utility Model Register or other equivalent documents, the Commissioner of the Korean Intellectual Property Office shall reissue the utility model registration certificate with amendments, or issue a new utility model registration certificate upon request or *ex officio*.

(3) When a trial decision for a correction under Article 51(1) of this Act has become final, the Commissioner of the Korean Intellectual Property Office shall issue a new utility model registration certificate in accordance with the trial decision.

Article 34 *Mutatis Mutandis* Application of the Patent Act

Articles 80 and 83 of the Patent Act apply *mutatis mutandis* to registration fees and utility model registrations.

CHAPTER V

UTILITY MODEL RIGHT

Article 35 Registration of Establishment of a Utility Model Right and Publication of Registration

- (1) A utility model right comes into effect upon registration of its establishment.
- (2) The Commissioner of the Korean Intellectual Property Office shall register the establishment of a utility model right unless the utility model application comes under the subparagraphs of Article 11 or the subparagraphs of Article 12, or has been abandoned or withdrawn. However, if a situation in either of the following subparagraphs applies, the Commissioner of the Korean Intellectual Property Office shall register the establishment of the utility model right only if a corresponding patent right has been abandoned:
- (i) where a patent application is the basis for a dual application, and the establishment of the patent right is registered; or
 - (ii) where a patent application is based on a utility model application under Article 53 of the Patent Act (referred to as a dual application), and the establishment of the patent right from the dual application is registered.
- (3) Where a registration has been made under paragraph(2), the Commissioner of the Korean Intellectual Property Office shall publish the registration of the utility model with relevant information in the Utility Model Gazette.
- (4) The Commissioner of the Korean Intellectual Property Office shall reserve publication of a utility model registration under paragraph(3) if the utility model application is ordered to be treated confidentially under Article 41(1) of the Patent Act as applied *mutatis mutandis* under Article 20 of this Act until it is declassified; upon declassification, the Commissioner shall immediately publish the registration.

(5) The Commissioner of the Korean Intellectual Property Office shall make application documents and attached materials available for public inspection for a period of three months after the publication date of the registration under paragraph (3).

(6) When a registration is published under paragraph (3), any person may submit to the Commissioner of the Korean Intellectual Property Office information with supporting evidence that the device falls under any subparagraph of Article 25(1).

(7) Matters to be published in the Utility Model Gazette regarding publication of registrations under paragraph (3) are prescribed by Presidential Decree.

Article 36 The Term of a Utility Model Right

(1) The term of a utility model right commences upon registration of the utility model under Article 35(1) and remains in force for ten years after the filing date of the utility model application.

(2) Where a utility model right is granted to a lawful holder of the right under Article 35 of the Patent Act as applied *mutatis mutandis* under Article 20 of this Act, the term of the utility model right under paragraph (1) is calculated from the date following the filing date of the utility model application filed by the unentitled person.

(3) Deleted.

(4) Where for a utility model right that a utility model application is deemed to have been filed at the time of filing a dual application under Article 15(2) of this Act, the utility model term under paragraph (1) commences from the utility model registration date and remains in force for ten years after the filing date of the patent application on which the dual application is based.

Article 37 Effects of a Utility Model Right

The owner of a utility model right has an exclusive right to work the registered utility model commercially and industrially. However, where the

utility model right is the subject of an exclusive license, this provision does not apply to the extent that the exclusive licensee has the exclusive right to work the registered utility model under Article 100(2) of the Patent Act as applied *mutatis mutandis* under Article 42 of this Act.

Article 38 Limitations on a Utility Model Right

The effects of a utility model right do not extend to the following:

- (i) working a registered utility model for research or experimentation;
- (ii) vessels, aircraft or vehicles merely passing through the Republic of Korea or machinery, instruments, equipment or other accessories used on the vessels, aircraft or vehicles; or
- (iii) articles existing in the Republic of Korea at the time the utility model application was filed.

Article 39 Relation between Similar Registered Utility Models

Where working a registered utility model would utilize another person's registered utility model, patented invention or registered design or a design similar to the registered design under an application filed before the filing date of the application for the registered utility model, or where a utility model right conflicts with another person's design right or trademark right under an application for design or trademark registration filed before the filing date of the application for the registered utility model, the owner of the utility model right or exclusive or nonexclusive licensee may not work the registered utility model commercially or industrially without the license of the owner of the earlier utility model, patent, design right or trademark right, unless a nonexclusive license is obtained by a trial under Article (53)(1).

Article 40 Nonexclusive License Due to Working before the Registration of a Request for an Invalidation Trial

(1) Where a person falling under any of the following subparagraphs, before

the registration of a request for an invalidation trial of a relevant registered utility model or patent, has been commercially or industrially working a device in the Republic of Korea in good faith, or has been making preparations to work the device, without knowing that the registered utility model or patent is subject to invalidation, regardless of whether the utility model registration is based on a decision of maintenance under Article 25(2) of this Act or whether the person has given substantial attention to such matters, or has been commercially or industrially working an invention in the Republic of Korea in good faith, or has been making preparation to work the invention, without knowing that the patent was subject to invalidation, the person is entitled to have a nonexclusive license on that utility model or patent right or on the exclusive license existing at the time the utility model registration or patent was invalidated. However, the nonexclusive license must be limited to the device or invention being worked or for which preparations for working are being made and to the purpose of the working or preparations:

- (i) the original owner of a utility model right, where one of two or more utility model registrations granted for the same device has been invalidated;
- (ii) the original owner of a patent right, where a registered utility model and a patented invention are the same and the patent has been invalidated;
- (iii) the original owner of a utility model right, where the original owner's utility model registration has been invalidated and a utility model registration for the same device has been granted to an entitled person;
- (iv) the original patentee, where the original patentee's patent has been invalidated and a utility model registration for the same device as the invention has been granted to an entitled person; or
- (v) in cases referred to in subparagraphs (i) to (iv), a person who, at the time of registration of the request for an invalidation trial of an invalidated utility model or patent right, has been granted an exclusive license or a nonexclusive license, or a nonexclusive

license on the exclusive license, and the license has been registered. However, a person falling under Article 118(2) of the Patent Act is not required to register the license.

(2) A person granted a nonexclusive license under paragraph(1) shall pay reasonable remuneration for the nonexclusive license to the owner of a utility model right or the exclusive licensee.

Article 41 Nonexclusive License after a Design Right Expires

(1) Where a design right filed and registered on or before the filing date of a utility model application conflicts with the utility model right, and the term of the design right has expired, the owner of the design right is entitled to have a nonexclusive license on the utility model right to the extent of the design right, or on the exclusive license existing at the time the design right expired.

(2) Where a design right filed and registered on or before the filing date of a utility model application conflicts with the utility model right, and the term of the design right has expired, a person who, at the time of expiry, has an exclusive license on the expired design right or a nonexclusive license (limited to the nonexclusive license under Article 118(1) of the Patent Act as applied *mutatis mutandis* under Article 61 of the Industrial Design Act) on the expired design right or on the exclusive license is entitled to have a nonexclusive license, to the extent of the scope of the expired right, on the utility model right or on the exclusive license existing at the time the design right expired.

(3) A person granted a nonexclusive license under paragraph(2) shall pay reasonable remuneration for the nonexclusive license to the owner of the utility model right or the exclusive licensee.

Article 42 *Mutatis Mutandis* Application of the Patent Act

Articles 97, 99 to 103, 106 to 116 and 118 to 125 and 125*bis* of the Patent Act apply *mutatis mutandis* to a utility model right.

CHAPTER VI

PROTECTION OF OWNER OF UTILITY MODEL RIGHT

Article 43 Acts Considered to be an Infringement

Commercial acts of manufacturing, assigning, leasing or importing, or the act of offering for commercial or industrial assignment or lease, of goods used exclusively for manufacturing a product related to a utility model registration are considered to infringe a utility model right or an exclusive license under the utility model registration.

Article 44 Presentation of a Certified Copy of the Decision to Maintain a Utility Model Registration

The owner of a utility model right or an exclusive licensee may exercise the right against a person who infringes the utility model right or exclusive license only after warning the person by presenting a certified copy of the decision to maintain a utility model registration under Article 25(2) of this Act.

Article 45 Liability of the Owner of a Utility Model Right

(1) Where the decision to revoke a utility model right under Article 74(3) of the Patent Act as applied *mutatis mutandis* under Article 48 of this Act, or the decision to invalidate a utility model right (except for a trial decision under Article 49(1)(iv) of this Act), has become final, and after exercising the right or warning a person who has infringed the utility model right or exclusive license, the owner or exclusive licensee of the utility model right is liable to compensate a person who suffers from the exercise of the right or the warning. However, where the utility model registration is based on a decision of maintenance under Article 25(2) of this Act or where the owner or exclusive licensee has paid substantial and diligent attention to the exercise of the right or the warning, this provision does not apply.

(2) Paragraph (1) applies *mutatis mutandis* when a right is exercised or a warning is given for that portion of a right excluded from the scope of a device described in the claim(s) when a utility model application was registered because of a correction to the description and drawing(s) attached to the utility model application in accordance with a request and trial for a correction.

Article 46 *Mutatis Mutandis* Application of the Patent Act

Articles 126, 128, 130, 131 and 132 of the Patent Act apply *mutatis mutandis* to protection of the owner of a utility model right. In such cases, "a person who has infringed a patent right or exclusive license of another person" in Article 130 of the Patent Act is deemed "a person who has infringed a utility model right or exclusive license of another person who has been granted a decision to maintain a utility model registration under Article 25(2) of this Act".

CHAPTER VII

OPPOSITION TO REGISTRATION OF A UTILITY MODEL

Article 47 Opposition to Registration of a Utility Model

(1) Within three months of the publication of a utility model registration, any person may file an opposition to the utility model registration with the Commissioner of the Korean Intellectual Property Office on the grounds that the utility model registration falls under any of the following subparagraphs. Where the registered utility model contains two or more claims, an opposition may be filed for each claim:

- (i) where the utility model has been registered contrary to Article 25

of the Patent Act as applied *mutatis mutandis* under Article 4 of this Act, Articles 5, 7, 8(1) to (4) of this Act, Articles 44 of the Patent Act as applied *mutatis mutandis* under Article 20 of this Act;

- (ii) where a person is not entitled to a patent under Article 33(1) of the Patent Act as applied *mutatis mutandis* under Article 20 of this Act or where a patent may not be granted under the proviso of Article 33(1) of the Patent Act;
- (iii) where the registration of a utility model violates a treaty;
- (iv) where the registration of a utility model violates Article 9(3) or (4); or
- (ivbis) where the amendment is beyond the scope of Article 14.
- (v) where the registration of a utility model violates the proviso of Article 35(2).

(2) When filing an opposition, the opponent (referred to as "the opponent filing the opposition") shall file a written opposition with the relevant evidence before the Commissioner of the Korean Intellectual Property Office. The opposition must state the following:

- (i) the name and address of the opponent (and, if a legal entity, the name and address of the business);
- (ii) the name and residential or business address of the agent, if any (and, if the agent is a patent legal entity, the name and address of the business and the name of the designated patent attorney);
- (iii) identification of the utility model registration to which the opposition pertains; and
- (iv) the grounds for the opposition and identification of relevant evidence.

(3) Article 49(4) of this Act applies *mutatis mutandis* to an opposition to the registration of a utility model.

Article 48 *Mutatis Mutandis* Application of the Patent Act

Articles 70 to 78*bis* of the Patent Act apply *mutatis mutandis* to an opposition to a utility model registration. In Article 77(3) of the Patent Act, "Articles 136(2) to 136(5)" reads "Articles 136(2), (3) and (5)", and in Article 78(1) of the Patent Act "a decision on an opposition" reads "a decision on a request for technical evaluation or a decision on an opposition".

CHAPTER VIII

TRIALS, RETRIALS AND LITIGATION

Article 49 Trial for Invalidation of Utility Model Registration

(1) Any interested party or an examiner may request a trial to invalidate a utility model registration under any of the following subparagraphs; when the registered utility model contains two or more claims, a request for an invalidation trial may be made for each claim:

- (i) where the registration of a utility model violates Article 25 of the Patent Act as applied *mutatis mutandis* under Article 4 of this Act, Articles 5, 7, 8(1) to (4) and 9(3) and (4) of this Act, or Article 44 of the Patent Act as applied *mutatis mutandis* under Article 20 of this Act;
- (ii) where the utility model has been registered to a person who is not entitled to the utility model right under Article 33(1) of the Patent Act as applied *mutatis mutandis* under Article 20 of this Act, or who may not obtain a patent under the proviso of Article 33(1) of the Patent Act;

- (iii) where the registration of a utility model violates a treaty;
- (iv) where, following the registration of the utility model, the owner of the utility model right is no longer capable of enjoying the utility model right under Article 25 of the Patent Act as applied *mutatis mutandis* to Article 4 of this Act, or the utility model registration no longer complies with a treaty;
- (ivbis) where the amendment is beyond the scope stipulated under Article 14; or
- (v) where the registration of a utility model violates the proviso of Article 35(2) of this Act.

(2) A request for a trial under paragraph(1) may be made even after the extinguishment of a utility model right.

(3) Where a trial decision invalidating a utility model registration has become final, the utility model right is deemed never to have existed; however, where a trial decision invalidating a utility model registration under paragraph(1)(iv) has become final, the utility model right is deemed not to have existed from the time the utility model registration first became subject to paragraph (1)(iv).

(4) Where a request for a trial under paragraph(1) has been made, the presiding trial examiner shall notify the exclusive licensee of the utility model right and any other persons who have registered rights related to the utility model registration of the contents of the request.

Article 49bis Correction of Utility Model Registration under Trial for Invalidation of Utility Model Registration

(1) The owner of a utility model right who demands a trial for invalidation under Article 49(1) of this Act may only request a correction of the description or drawing(s) in a utility model registration when the subparagraphs of Article 27(2) of this Act apply.

(2) A request for correction under paragraph(1) may be made within the period prescribed in Article 147(1) of the Patent Act or the proviso of Article 159(1) of the Patent Act as applied *mutatis mutandis* under Article 56 of this Act.

(3) Where a request for correction is submitted under paragraph(1), the presiding trial examiner shall transmit a certified copy of the request to the petitioner of the trial under Article 49(1).

(4) Articles 51(2) to (4), (6) to (10) and 55(1), (2) and (5) of this Act and Article 139(3) of the Patent Act as applied *mutatis mutandis* under Article 56 of this Act apply *mutatis mutandis* to a request for correction to a utility model registration under paragraph (1). In such cases, "only before a notice under Article 162(3) of the Patent Act as applied *mutatis mutandis* under Article 56 of this Act (where proceedings are reopened under Article 162(4) of the Patent Act, before issuance of the notice of concluded proceedings under Article 162(3) of the Patent Act)" in Article 51(9) of this Act reads "within the prescribed period if notice is issued under Article 51(4) of this Act".

Article 50 Trial to Confirm the Scope of a Utility Model Right

An owner of a utility model right or any interested person may request a trial to confirm the scope of a registered utility model. A trial may be requested for each claim if the registered utility model contains two or more claims.

Article 51 Trial for Correction

(1) The owner of a utility model right may request a trial for a correction of the description or drawing(s) of the registered utility model under any subparagraph of Article 27(2) unless a technical evaluation, an opposition against the registration or a trial for invalidation of a utility model registration is pending before the Korean Intellectual Property Office or before the Intellectual Property Tribunal.

(2) A correction to the description or drawing(s) under paragraph (1) must be within the scope of the features disclosed in the description or drawing(s)

attached to the utility model application. (Where a correction is made under Article 27(2)(ii), it must be within the scope of the features disclosed in the description or drawing(s) originally attached to the utility model application.)

(3) A correction to the description or drawing(s) under paragraph (1) must neither substantially expand nor modify the scope of the claim(s).

(4) A trial examiner who determines that a request for a trial under paragraph 1 does not fall under any subparagraph of Article 27(2) or that the request does not comply with paragraphs 2 or 3 shall notify the requester of the reason for the decision and give the requester an opportunity to submit a written response within a designated period.

(5) A trial for a correction under paragraph (1) may be requested even after a utility model right has been extinguished. However, where the utility model registration has been revoked by a decision to revoke under Article 74(3) of the Patent Act as applied *mutatis mutandis* under Article 25(1) or 48, or invalidated by a trial decision to invalidate, this provision does not apply.

(6) The owner of a utility model right may not request a trial for a correction under paragraph (1) without the consent of an exclusive licensee, a pledgee or a nonexclusive licensee, under Article 39(1) of the Patent Act as applied *mutatis mutandis* under Article 20 of this Act, and Articles 100(4) and 102(1) of the Patent Act as applied *mutatis mutandis* under Article 42 of this Act.

(7) Where the description or drawing(s) of a registered utility model have been corrected by a trial under paragraph (1), the President of the Intellectual Property Tribunal shall notify the Commissioner of the Korean Intellectual Property Office of the content of the correction.

(8) Where a trial decision to allow a correction to the description or drawing(s) of a registered utility model becomes final, the utility model application and registration of the establishment of the utility model right are deemed to have been made on the basis of the corrected description or drawing(s).

(9) A person who requests a trial under paragraph (1) may correct the description or drawing(s) attached to the request for a trial under

Article 55(5) of this Act only if the request is submitted before issuance of a notification under Article 162(3) of the Patent Act as applied *mutatis mutandis* under Article 56 of this Act (where proceedings have been reopened under Article 162(4) of the Patent Act, before issuance of the notification of closure of the proceedings under Article 162(3) of the Patent Act).

(10) The Commissioner of the Korean Intellectual Property Office publish a notice in the Utility Model Gazette when a notice under paragraph(7) has been given.

Article 52 Trial to Invalidate a Correction

(1) An interested party or an examiner may request a trial for an invalidation of a correction under Articles 27(1), 49*bis*(1) and 51(1) of this Act, or Article 77(1) of the Patent Act as applied *mutatis mutandis* under Article 48 of this Act, where the description or drawing(s) of a registered utility model have been corrected contrary to any of the following subparagraphs:

- (i) any subparagraph of Article 27(2);
- (ii) Article 51(2) or (3) (including cases that apply *mutatis mutandis* under Article 49*bis*(4)); or
- (iii) either paragraph (2) or (4) of Article 136 or identical provisions under Article 77(3) of the Patent Act as applied *mutatis mutandis* under Articles 27(4) or 48 of this Act.

(2) Article 49(2) and (4) applies *mutatis mutandis* to a request for a trial under paragraph (1).

(3) The owner of a utility model right who has requested a trial under paragraph(1) may request a correction to the description or drawing(s) of a utility model registration under Article 147(1) or the latter part of Article 159(1) of the Patent Act as applied *mutatis mutandis* under Article 56 of this Act within the designated period only if any subparagraph of Article 27(2) of this Act applies.

(4) Article 49bis(3) and (4) applies *mutatis mutandis* to a request for a correction under paragraph(3). In such cases, "Article 49(1)" in Article 49bis(3) reads "Article 52(1)".

(5) Where a trial decision invalidating a correction to the description or drawing(s) under paragraph(1) has become final, the correction is deemed to have never been made.

Article 53 Trial to Grant a Nonexclusive License

(1) Where the owner of a utility model right or an exclusive or nonexclusive licensee seeks permission to exercise the registered utility model under Article 39 and the other person refuses permission without justifiable reasons or permission is impossible to obtain, the owner or exclusive or nonexclusive licensee may request a trial to grant a nonexclusive license with the scope necessary to work the registered utility model.

(2) When a trial under paragraph (1) has commenced, a nonexclusive license may be granted only where the registered utility model of the later application constitutes an important technical advance that has substantial economic value in comparison to the other person's registered utility model or patented invention for which an application was filed before the filing date of the later application.

(3) If a person ordered to grant a nonexclusive license in accordance with a trial under paragraph(1) needs to work the registered utility model of the party who has been granted the nonexclusive license, and if the party refuses to give permission or if permission is impossible to obtain, the person may request a trial for the grant of a nonexclusive license with the scope necessary to work the registered utility model.

(4) A party granted a nonexclusive license under paragraphs (1) and (3) shall remunerate the owner of the utility model right, the patentee, the owner of the design right or the exclusive licensee; if payment is not possible for unavoidable reasons, the remuneration must be placed in deposit.

(5) A nonexclusive licensee under paragraph(4) may not work a registered

utility model, a patented invention or a registered design or a similar design without paying the remuneration or placing a deposit.

Article 54 Trial against a Decision to Revoke a Utility Model Registration

A person who has received a decision to revoke a utility model registration under Article 25(1) of this Act or Article 74(3) of the Patent Act as applied *mutatis mutandis* under Article 48 of this Act, and who does not agree with the ruling, may request a trial within thirty days of the date of receiving a certified copy of the ruling.

Article 54bis Trial against a Decision to Reject a Utility Model Application

Where a person who receives a decision to reject under Article 12(3) is dissatisfied with the decision, the person may request a trial within thirty days of receiving of a certified copy of the decision.

Article 55 Formal Requirements of a Request for a Trial

(1) A person requesting a trial shall submit a written request to the President of the Intellectual Property Tribunal, stating the following:

- (i) the names and addresses of the parties (and, if a legal entity, the name and address of the business);
- (ii) the name and residential or business address of the agent, if any (and, if the agent is a patent legal entity, the name and address of the business and the name of the designated patent attorney);
- (iii) identification of the trial case; and
- (iv) the purpose and grounds of the request.

However, in a request for a trial against a decision to revoke under Article 54 of this Act or a trial against a decision to reject under Article 54*bis* of this Act, Article 140*bis*(1) of the Patent Act applies.

(2) An amendment to a request for a trial submitted under paragraph (1) may not change the intent or purpose of the request unless the grounds for the request are amended under subparagraph (1)(iv).

(3) In addition to the particulars referred to in paragraph (1), a written request for a trial under Article 53(1) must state the following:

- (i) the number and title of the utility model registration that is required to be worked;
- (ii) the number, title and date of the other party's patented invention, registered utility model or registered design to be worked; and
- (iii) the scope, duration and remuneration for the nonexclusive license for the patented invention, the registered utility model or the registered design.

(4) When a trial is requested to confirm the scope of a utility model right under Article 50, the explanation and the necessary drawing(s) that can be compared with the registered utility model must be attached to the written request.

(5) When a trial for a correction under Article 51(1) is requested, the corrected description or drawing(s) must be attached to the written request for a trial.

Article 56 *Mutatis Mutandis* Application of the Patent Act

Articles 139, 140*bis*(2), 141 to 166, 171(2), 172, 176 and 178 to 191 of the Patent Act apply *mutatis mutandis* to trials, appellate trials, retrials and litigation. In this case, "the opponent" in Article 140*bis*(2) of the Patent Act reads "a person who requests a technical evaluation or an opponent"; "the decision on a patent opposition" in Article 164(1) reads "the decision on a

request for technical evaluation or an opposition to a utility model registration", and "an examination or an opposition" in Article 172 reads "an examination, technical evaluation of a utility model or an opposition to a utility model registration".

CHAPTER IX

INTERNATIONAL APPLICATIONS UNDER THE PATENT COOPERATION TREATY

Article 57 Utility Model Application Based on an International Application

(1) Where an international application for which an international filing date has been recognized under the Patent Cooperation Treaty designates the Republic of Korea as a designated State to obtain a utility model registration, the application is considered to be a utility model application filed on its international filing date.

(2) Article 54 of the Patent Act as applied *mutatis mutandis* under Article 20 of this Act does not apply to an international application considered to be a utility model application filed on its international filing date under paragraph (1) (referred to as "an international utility model application").

Article 58 Special Provision on Devices Considered to be Novel

Notwithstanding Article 6(2), any person applying Article 6(1)(i) and (iii) to a device claimed in an international utility model application may submit a written statement to that effect and documents substantiating that the device falls under Article 6(1)(i) and (iii) to the Commissioner of the Korean Intellectual Property Office within the period prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

Article 59 Translation of International Utility Model Application

(1) An applicant who has filed an international utility model application in a foreign language shall submit to the Commissioner of the Korean Intellectual Property Office, a Korean translation of the description, claim(s), textual matter of the drawing(s) and the abstract filed on the international filing date, within a period (referred to as "the domestic period for submitting documents") that is not more than two years and six months after the priority date as defined in Article 2(xi) of the Patent Cooperation Treaty (referred to as "the priority date"). However, if the claim(s) of an international utility model application have been amended under Article 19(1) of the Patent Cooperation Treaty, the applicant is only required to submit a Korean translation of the amended claim(s).

(2) Where a Korean translation of the description and claim(s) under paragraph(1) have not been submitted within the domestic period for submitting documents, the international utility model application is deemed to have been withdrawn.

(3) An applicant who has submitted the Korean translation referred to in paragraph(1) may submit a new translation to replace the earlier translation only within the designated domestic period for submitting documents. If the applicant has made a request under Article 23(2) or 40(2) of Patent Cooperation Treaty (referred to as "a request for domestic treatment"), this provision does not apply.

(4) Matters that were disclosed in the description, claim(s) and textual matter of the drawing(s) of an international utility model application filed on the international filing date but not disclosed in the translation under paragraphs (1) or (3) (referred to as "the translated version") submitted within the domestic period for submitting documents (or the date of the request for an examination where the applicant has made the request within the appropriate period, referred to as "the relevant date") are deemed not to have been disclosed in the description, claim(s) and textual matter of the drawing(s) of the international utility model application filed on the international filing date.

(5) An application submitted on the international filing date of an

international utility model application is deemed to be an application submitted under Article 9(1).

(6) The translated version of the description, claim(s), drawing(s) and abstract of an international utility model application (or the description, claim(s), drawing(s) and abstract submitted on the international filing date if the international utility model application is filed in the Korean language) is deemed to be the description, claim(s), drawing(s) and abstract submitted under Article 9(2).

(7) Article 63(1) and (2) does not apply where a Korean translation of the amended claim(s) has been submitted under the proviso of paragraph (1).

(8) Where a Korean translation has been submitted under the proviso of paragraph(1) only for the amended claim(s), the claim(s) submitted on the international filing date are not recognized.

Article 60 Special Provisions on Claim of Priority

(1) Articles 18(2) and 19(2) do not apply to an international utility model application.

(2) For the purpose of Article 18(4) regarding an international utility model application, "description or drawing(s) originally attached to an earlier application" reads "description, claim(s) and textual matter of the drawing(s) submitted on the international filing date under Article 59(1), and the translated version of the documents or drawing(s) (except the textual matter of the drawing(s)) of the international application submitted on the international filing date" and "laying open for public inspection" reads "laying open for public inspection or international publication under Article 21 of the Patent Cooperation Treaty".

(3) For the purpose of Articles 18(1), (3), (4) and 19(1), where the earlier application under Article 18(1) is the international utility model application or international patent application under Article 199(2) of the Patent Act, "description or drawing(s) originally attached to a model application" in Article 18(1) and (3) reads "description, claim(s) and drawing(s) of an

international application submitted on the international filing date under Article 59(1) of this Act or Article 201(1) of the Patent Act"; "description or drawing(s) originally attached to the earlier application" in Article 18(4) reads "description, claim(s) or drawing(s) of an international application concerning an earlier application submitted on the international filing date under Article 59(1) of this Act or Article 201(1) of the Patent Act"; "laying open of the earlier application for public inspection" reads "international publication concerning the earlier application under Article 21 of the Patent Cooperation Treaty"; and "one year and three months after the filing date" in Article 19(1) reads "at the relevant date under Article 59(4) of this Act or Article 201(4) of the Patent Act or one year and three months after the international filing date under Article 59(1) of this Act or Article 201(1) of the Patent Act, whichever date expires later," respectively.

(4) For the purpose of Articles 18(1), (3) and (4) or 19(1), where the earlier application under Article 18(1) is an international utility model application recognized as a utility model application or a patent application under Article 71(4) of this Act or Article 214(4) of the Patent Act, "description or drawing(s) originally attached to the application" in Articles 18(1) and (3) reads "description, claim(s) or drawing(s) of an international application as of the date regarded as the international filing date under Article 71(4) of this Act or Article 214(4) of the Patent Act" and "description or drawing(s) originally attached to the earlier application" in Article 18(4) reads "description, claim(s) or drawing(s) of an international application concerning an earlier application as of the date regarded as the international filing date under Article 71(4) of this Act or Article 214(4) of the Patent Act" and "one year and three months after the filing date of the earlier application" in Article 19(1) reads "within one year and three months of the date regarded as the international filing date under Article 71(4) of this Act or Article 214(4) of the Patent Act or at the time of making a decision under Article 71(4) of this Act or Article 214(4) of the Patent Act, whichever date expires later," respectively.

Article 61 Submission of Documents

(1) An applicant for an international utility model application shall submit a document to the Commissioner of the Korean Intellectual Property Office

within the domestic period for submitting documents, stating the following; furthermore, under Article 59(1), an applicant who files the application in a foreign language shall submit the document with a Korean translation:

- (i) the name and address of the applicant (and, if a legal entity, the name and address of the business);
- (ii) the name and residential or business address of the agent, if any (and, if the agent is a patent legal entity, the name and address of the business and the name of the designated patent attorney);
- (iii) deleted;
- (iv) the title of the device;
- (v) the name and residential or business address of the deviser; and
- (vi) the international filing date and the international application number.

(2) If the submission of documents falls under either of the following subparagraphs, the Commissioner of the Korean Intellectual Property Office shall order amendments within a designated period:

- (i) where the document under paragraph (1) was not submitted within the domestic period for submitting documents; or
- (ii) where the document under paragraph (1) fails to comply with the formalities prescribed in this Act or any order under this Act.

(3) Where a person who has been instructed to make an amendment under paragraph (2) fails to make an amendment within the designated period, the Commissioner of the Korean Intellectual Property Office may invalidate the international utility model registration application.

Article 62 Submission of Drawings

(1) An applicant for an international utility model application shall submit a drawing or drawings (including a brief description of the drawing(s)) to the

Commissioner of the Korean Intellectual Property Office no later than the relevant date if no drawing of the international application submitted on the international filing date is included.

(2) The Commissioner of the Korean Intellectual Property Office may require the applicant for an international utility model application to submit a drawing or drawings within a designated period when the drawing(s) under paragraph(1) have not been submitted on or before the relevant date. The same procedure applies where the Korean translation of the textual matter of the drawing(s) under Article 59(1) or (3) has not been submitted by the relevant date.

(3) The Commissioner of the Korean Intellectual Property Office may invalidate an international utility model application where the applicant required to submit the drawing(s) under paragraph(2) has failed to do so within the designated period.

(4) A drawing submitted under paragraph (1) or(2) is deemed to be an amendment under Article 13(1) of this Act. However, the period allowed for amendment under Article 13(1) of this Act does not apply to such a drawing.

Article 63 Amendment after Receipt of the International Search Report

(1) Where the claim(s) of an international utility model application have been amended after receiving the international search report under Article 19(1) of the Patent Cooperation Treaty, the applicant of the international utility model application shall submit to the Commissioner of the Korean Intellectual Property Office a Korean translation of the amendment no later than the relevant date.

(2) Where a Korean translation of an amendment has been submitted under paragraph(1), the claim(s) are deemed to have been amended under Article 13(1) by the Korean translation.

(3) Where a statement under Article 19(1) of the Patent Cooperation Treaty has been submitted to the International Bureau under Article 2(xix) of the

Treaty (referred to as "the International Bureau"), the applicant of an international utility model application shall submit to the Commissioner of the Korean Intellectual Property Office a Korean translation of the statement.

(4) If an applicant for an international utility model application has not submitted the Korean translation of the amendment or statement under paragraph(1) or (3) on or before the relevant date, the amendment or statement under Article 19(1) of the Patent Cooperation Treaty are deemed not to have been submitted.

(5) The period for an amendment prescribed in Article 13(1) does not apply to an amendment under paragraph (2).

Article 64 Amendment before Establishment of the International Preliminary Examination Report

(1) Where the description, claim(s) and drawing(s) of an international utility model application have been amended before the establishment of the International Preliminary Examination Report under Article 34(2)(b) of the Patent Cooperation Treaty, the applicant of an international utility model application shall submit to the Commissioner of the Korean Intellectual Property Office a Korean translation of the amendment no later than the relevant date.

(2) Where a Korean translation of the amendment has been submitted under paragraph(1), the description and drawing(s) are deemed to have been amended under Article 13(1) by the Korean translation.

(3) If an applicant for an international utility model application has not followed the procedure under paragraph(1) on or before the relevant date, the amendment under Article 34(2)(b) of the Patent Cooperation Treaty are deemed not to have been submitted.

Article 65 Special Provision on Amendments

(1) Notwithstanding Article 13(1), no amendment to an international utility model application (except an amendment under Articles 63(2) and 64(2))

may be made until the registration fees prescribed under Article 29(1) and the official fees prescribed under Article 30(1) have been paid, a Korean translation of the application under Article 59(1) (except the case of an international utility model application made in the Korean language) has been submitted, and the relevant date has passed.

(2) The proviso of Article 13(1) does not apply to an amendment of an international utility model application under Articles 28(1) or 41(1) of the Patent Cooperation Treaty.

(3) With regard to the scope of an amendment to an international utility model application, "the description or drawing(s) originally attached to the utility model application" in Article 14 reads "the features disclosed in the translated version of the description, claim(s) or textual matter of the drawing(s) of the international utility model application submitted on the international filing date or the drawing(s) (except the textual matter of the drawing(s)) of the international utility model application submitted on the international filing date".

Article 66 Time Restrictions on Filing a Dual Application

Notwithstanding Article 17(1), a dual utility model application that is based on an international application considered to be a patent application filed on its international filing date under Article 199(1) of the Patent Act may not be filed until the official fees prescribed under Article 82(1) of the Patent Act have been paid and a translation (except for an international patent application filed in the Korean language) under Article 201(1) of the Patent Act has been submitted. However, a dual utility model application that is based on an international application considered to have been filed on the date recognized as the international filing date under Article 214(4) of the Patent Act may not be filed until the decision under Article 214(4) of the Patent Act has been made.

Article 67 Special Provision on Oppositions against a Utility Model Registration

A person may file an opposition against the registration of an international

utility model application on the grounds that the device does not fall under either of the following subparagraphs nor under any subparagraph of Article 47(1):

- (i) the device is disclosed in the description, claim(s) or textual matter of the drawing(s) of an international application submitted on the international filing date and in the translated version; or
- (ii) the device is disclosed in the drawing(s) (excluding the textual matter of the drawing(s)) of an international application submitted on the international filing date.

Article 68 Special Provisions on an Invalidation Trial of a Utility Model Registration

A person may request a trial to invalidate a utility model registration for an international application on the grounds that the device does not fall under either of the following subparagraphs or under any subparagraph of Article 49(1):

- (i) the device is disclosed in the description, claim(s) or textual matter of the drawing(s) of an international application submitted on the international filing date and in the translated version; or
- (ii) the device is disclosed in the drawing(s) (excluding the textual matter of the drawing(s)) of an international application submitted on the international filing date.

Article 69 Time Restriction on Request for Technical Evaluation of Utility Model

With regard to a request for a technical evaluation of an international utility model application, "any person" in Article 21(1) reads "any person after the relevant date".

Article 70 Special Provisions on Paying Registration Fees

With regard to the registration fees for the first year for an international utility model application, "simultaneously with a utility model application (divisional application for a divisional application under Article 16 of this Act or dual application for a co-filing under Article 17 of this Act)" in Article 29(2) reads "within the domestic period for submitting documents under Article 59(1) (where a request for domestic treatment under Article 59(3) has been made, until the time of a request for domestic treatment)".

Article 71 International Application Considered to be a Utility Model Application by Decision

(1) Where the receiving office referred to in Article 2(xv) of the Patent Cooperation Treaty has refused to recognize an international filing date or has made a declaration of withdrawal of an international application under Article 25(1)(a) or (b) of the Patent Cooperation Treaty, or the International Bureau has made a finding that the recorded copy under Article 25(1)(a) has not been received under Article 25(1)(a) of the Patent Cooperation Treaty, for an international application that designates the Republic of Korea as a designated State, an applicant of the international application may request the Commissioner of the Korean Intellectual Property Office, as prescribed by ordinance of the Ministry of Commerce, Industry and Energy, to decide whether the refusal, declaration or finding is properly made under Article 25(2)(a) of the Treaty.

(2) A person making a request under paragraph (1) shall submit to the Commissioner of the Korean Intellectual Property Office a petition with a Korean translation of the description, claim(s), textual matter of the drawing(s) and other documents related to the international application as prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

(3) Where a request under paragraph (1) has been made, the Commissioner of the Korean Intellectual Property Office shall decide whether the refusal, declaration or finding referred to in the request was properly made under the Patent Cooperation Treaty and its Regulations.

(4) Where the Commissioner of the Korean Intellectual Property Office has decided under paragraph (3) that the refusal, declaration or finding was not properly made under the Patent Cooperation Treaty and its Regulations, the relevant international application is deemed to be a utility model application filed on the date that would have been recognized as the international filing date if the refusal, declaration or finding had not been made for the international application.

(5) Articles 57(2), 58, 59(4) to (8), 60(1) and (2), 62, 65, and 67 to 70 apply *mutatis mutandis* to an international application considered to be a utility model application filed on the date that would have been recognized as the international filing date under paragraph (4).

(6) With regard to the amendment of an international application considered to be a utility model application under paragraph (4), "the filing date of the utility model application" in Article 13(1) of this Act reads "date of decision that the refusal, declaration or finding was not properly made under Article 71(4)".

Article 72 *Mutatis Mutandis* Application of the Patent Act

Articles 192 to 198*bis*, 206, 210 and 211 of the Patent Act apply *mutatis mutandis* to international utility model applications. In this situation, "request an examination of the application" in Article 210 of the Patent Act reads "a request for domestic treatment".

CHAPTER X

SUPPLEMENTARY PROVISIONS

Article 73 Utility Model Gazette

(1) The Korean Intellectual Property Office shall publish the Utility Model Gazette.

(2) The Utility Model Gazette may be published in electronic media as prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

(3) When publishing the Utility Model Gazette in electronic media, the Commissioner of the Korean Intellectual Property Office shall publicize on a communication network matters regarding the Utility Model Gazette's publication, main contents and service.

Article 74 Special Provisions for a Utility Model Registration or Right with Two or More Claims

Under Article 74(4) of the Patent Act as it applies *mutatis mutandis* under Article 48 of this Act, Articles 21(2), 25(4), 31(1)(ii), 32(1)(i) (only in cases of extinguishment), 40(1)(i), 40(1)(iii) and (v) of this Act, Articles 101(1)(i) and 119(1) of the Patent Act as applied *mutatis mutandis* under Article 42 of this Act, Article 49(2) and (3) of this Act, Articles 51(5), 139(1), 181, 182, 104(1)(ii), (iv) and (v) of the Patent Act as applied *mutatis mutandis* under Article 56 of this Act, where a utility model registration or utility model right has two or more claims, the utility model registration is deemed to have been registered, or a utility model right is deemed to have been established, for each claim.

Article 75 Indication of Utility Model Registration

The owner of a utility model right or an exclusive or nonexclusive licensee may identify a utility model registration on the registered utility model product or on the product's container or packaging.

Article 76 Prohibition of False Indication

A person may not perform any of the following acts:

- (i) marking to indicate that a utility model registration has been granted or a utility model application has been filed, or any sign likely to cause confusion in a similar manner, on an article or on an article's

container or packaging, for which a utility model has not been registered or for which a utility model application is not pending;

- (ii) assigning, leasing or displaying an article that has been marked with an indication referred to in subparagraph (i); or
- (iii) for the purpose of manufacturing, using, assigning or leasing an article referred to in subparagraph (i), marking with an indication upon advertisements, signboards or tags that a utility model has been registered for the article or that a utility model application has been filed, or marking with any sign likely to cause such confusion.

Article 77 *Mutatis Mutandis* Application of the Patent Act

Articles 216, 217, 217*bis*, 218 to 220, 222 and 224*bis* of the Patent Act apply *mutatis mutandis* to a utility model. In this case "examination" in Articles 217 and 217*bis* of the Patent Act reads "technical evaluation of a utility model".

CHAPTER XI

PENAL PROVISIONS

Article 78 Offense of Infringement

(1) A person who infringes a utility model right or exclusive license is liable to imprisonment with labor not exceeding seven years or to a fine not exceeding 100 million won.

(2) Prosecution for offenses under paragraph (1) are initiated upon the filing of a complaint by an injured party.

Article 79 Offense of Perjury

(1) Having taken an oath under this Act, a witness, expert witness or interpreter who makes a false statement, gives a false expert opinion or interprets falsely before the Intellectual Property Tribunal is liable to imprisonment with labor not exceeding five years or a fine not exceeding 10 million won.

(2) Having committed an offense under paragraph (1), a person who admits the offense before the decision of an opposition or a trial decision related to a utility model registration becomes final may be partially or totally exempted from the application of the sentence.

Article 80 Offense of False Marking

A person who violates Article 76 of this Act is liable to imprisonment with labor not exceeding three years or to a fine not exceeding 20 million won.

Article 81 Offense of Fraud

A person who fraudulently or unjustly obtains a utility model registration, a decision on a technical evaluation, or an official or trial decision in an opposition to a utility model registration is liable to imprisonment with labor not exceeding three years or to a fine not exceeding 20 million won.

Article 82 Offense of Divulging Secrets

Any present or former officials of the Korean Intellectual Property Office or the Intellectual Property Tribunal who have disclosed or appropriated a device disclosed in a pending utility model application to which they had access during the course of their duties are liable to imprisonment with labor not exceeding two years or to a fine not exceeding 3 million won.

Article 83 Officers and Employees of Specialized Search Organization etc. as Public Officials and Irrefutable Presumption

A person who is or was an officer or employee of a specialized search organization or any agency that digitizes patent documents under Article 217*bis* of the Patent Act as applied *mutatis mutandis* under Article 77 of this Act is deemed to be a present or former official of the Korean Intellectual Property Office for the purpose of applying Article 82 of this Act.

Article 84 Dual Liability

Where a representative of a legal entity or an agent, employee or other servant of a legal entity or natural person violates Articles 78(1), 80 or 81 with regard to the business of the legal or natural person, the legal person in addition to the offender is liable to a fine as prescribed in either of the following paragraphs, and the natural person is liable to a fine prescribed in the relevant Article:

- (i) under Article 78(1), a fine not exceeding 300 million won;
- (ii) under Article 80 or 81, a fine not exceeding 60 million won.

Article 85 Confiscation etc.

(1) Any goods that are the subject of an act of infringement under Article 78(1) or any goods arising out of the act of infringement must be confiscated or, upon the request of the injured party, a judgment must be made requiring the goods to be delivered to the injured party.

(3) Where goods are delivered to the injured party under paragraph(1), the injured party may claim compensation of damages in excess of the value of the goods.

Article 86 Administrative Fine

(1) A person who commits any of the following acts is liable to an administrative fine not exceeding 500,000 won:

- (i) making a false statement before the Intellectual Property Tribunal after having taken an oath under Articles 299(2) and 367 of the Civil Procedure Act;
- (ii) failing to comply, without justifiable reasons, with an order of the Intellectual Property Tribunal to submit or show documents or other materials related to taking or preserving evidence;
- (iii) failing to comply, without justifiable reasons, with an order to report under Article 125 of the Patent Act as applied *mutatis mutandis* under Article 42 of this Act on matters related to working a registered utility model; or
- (iv) failing to comply, without justifiable reasons, with a subpoena of the Intellectual Property Tribunal to appear as a witness, an expert witness or an interpreter, or refusing to take an oath, make a statement, testify, give an expert opinion or interpret.

(2) The Commissioner of the Korean Intellectual Property Office shall impose and collect the administrative fine referred to in paragraph(1) as prescribed by Presidential Decree.

(3) A person who objects to the imposition of an administrative fine under paragraph(2) may protest to the Commissioner of the Korean Intellectual Property Office within thirty days of being notified of the imposition.

(4) Where a person who has been notified of the imposition of an administrative fine under paragraph(2) raises an objection under paragraph(3), the Commissioner of the Korean Intellectual Property Office shall immediately notify the competent court, which shall adjudicate the case of the administrative fine according to the Noncontentious Case Litigation Procedure Act.

(5) Where no objection has been raised within the period prescribed in paragraph(3) and where the fine has not been paid, the Commissioner of the Korean Intellectual Property Office shall collect the fine in accordance with the rules of collecting national taxes in arrears through the head of a competent tax office.

ADDENDUM

Article 1 Date of Entry into Force

This Act enters into force on July 1, 1999. However, Articles 28*bis* to 28*quinqüies* of the Patent Act as applied *mutatis mutandis* under Article 4 take effect on January 1, 1999, and provisions on the effect of the description, claim(s), drawing(s) and abstract of an application for international utility model registration filed in the Korean language in Article 59(6), provisions on the exemption of submission of the translation of an application for international utility model registration filed in the Korean language in Article 65(1), provisions on the exemption of submission of the translation of an application for an international patent filed in the Korean language in Article 210 of the Patent Act as applied *mutatis mutandis* under Article 72, and Articles 193(1) and 198*bis* of the Patent Act as applied *mutatis mutandis* under Article 72 apply on and after the date on which the agreement that the Government of the Republic of Korea concludes with the International Bureau on the selection of an international investigation agency takes effect for the Republic of Korea under Article 16(3)(b) of the Patent Cooperation Treaty.

Article 2 General Transitional Measures

An application for utility model registration, as well as its examination, utility model registration, utility model right, opposition to a utility model registration, trial, review, and lawsuits, filed under the previous provisions when this Act enters into force is subject to the previous provisions.

Article 3 Application Examples of Disposition of Procedures Related to a Utility Model by Means of Electronic Documents

Articles 28*ter* to 28*quinqüies* of the Patent Act as applied *mutatis mutandis* under Article 4 and Article 217*bis*(5) of the Patent Act as applied *mutatis mutandis* under Article 77 apply to an application for utility model registration filed on or after January 1, 1999.

Article 4 Application Examples of Requirements for Utility Model Registration

Article 5(3) applies when a device for which an application for utility model registration is filed after this Act enters into force (referred to as "a later-filed application" in this Article) is the same as a device described in the description or drawing(s) attached to an application for utility model registration that had been filed before the date of enforcement of this Act and has been laid open after the later-filed application.

Article 5 Special Cases for Applying the New Act to Previous Applications for Utility Model Registration

(1) Notwithstanding Article 2 of this addendum, upon the request of an applicant, the provisions apply to an application for utility model registration pending in the Korean Intellectual Property Office when this Act enters into force (excluding an application for which six years have elapsed since the date of its application as of the date this Act takes effect).

(2) A person applying the provisions under paragraph(1) shall submit a request to the Commissioner of the Korean Intellectual Property Office as prescribed by ordinance of the Ministry of Commerce, Industry and Energy within one year of the date on which this Act takes effect. However, a request for an international application deemed to be an application for utility model registration under the previous provisions of Articles 36(1) or 44(4) is allowed only if the translation and necessary documents under the previous provisions of Articles 37(1) and 38 are submitted and the fees are paid under the previous provisions of Article 17(1) when making the request.

(3) An application for utility model registration subject to this Act under paragraph(1) is deemed to have been filed on the filing date of the original application for utility model registration deemed to have been withdrawn on the date of the request under paragraph (1).

(4) Notwithstanding Article 13(1), amendment of the description, drawing(s) or abstract attached to an application for utility model registration that is subject to application of this Act under paragraph(1) may be made within the

period designated by ordinance of the Ministry of Commerce, Industry and Energy under Article 13(1) from the date on which a request is submitted under paragraph (2).

Article 6 Amending Other Acts

(1) The following provision of the Invention Promotion Act is amended as follows:

"Article 11 of the Utility Model Act" in Article 14 reads "Article 20 of the Utility Model Act".

(2) The following provision of the Court Organization Act is amended as follows.

"Article 35 of the Utility Model Act" in Article 28^{quater}(i) and Article 54^{bis}(2) reads "Article 55 of the Utility Model Act".

ADDENDUM

Article 1 Date of Entry into Force

This Act enters into force on July 1, 2001. However, amended Articles 10, 19(1), the portions of Article 28^{bis} that pertain to Articles 141 and 142 of the Patent Act, Articles 31(2) and (3) and 217(1) of the Patent Act as applied *mutatis mutandis* under Articles 77 and 83 enter into force on the date of its promulgation.

Article 2 Transitional Provision on Requirements for a Utility Model

Amended Articles 5(1)(ii) and 6(1)(i)(c) apply to applications for utility model registration initially filed after this Act enters into force.

Article 3 General Transitional Measures

Examination of the basic requirements for utility models, utility model

registration and rights, oppositions to utility model registration, trials, retrials and litigation with respect to utility model registration applications filed under the previous provisions when this amended Act enters into force is subject to the previous provisions, except in the following cases:

- (i) where a technical evaluation of a utility model is conducted, Article 77(3) of the Patent Act as applied *mutatis mutandis* under amended Article 27(4) applies. In such a case, only Article 136(9) of the Patent Act as applied *mutatis mutandis* under Article 77(3) of the Patent Act applies;
- (ii) where a request for a technical evaluation is dismissed, Article 141 of the Patent Act as applied *mutatis mutandis* under amended Article 28*bis* applies;
- (iii) where a utility model right is deemed to exist retroactively by late payment of the registration fees, amended Article 29*ter* applies;
- (iv) where an opposition to a utility model registration is requested, Article 77(3) of the Patent Act as applied *mutatis mutandis* under Article 48 applies. In such cases, only Article 136(9) of the Patent Act as applied *mutatis mutandis* under the Article 77(3) of the Patent Act applies; or
- (v) where a trial for invalidation of a utility model registration is requested, amended Article 49*bis*(1) to (3) and Articles 51(2) to (4), (6) to (10), 55(1), (2) and (5) as applied *mutatis mutandis* under amended Article 49*bis*(4) apply, respectively.

ADDENDUM

Article 1 Date of Entry into Force

This Act enters into force on July 1, 2002.

Articles 2 to 7 Deleted

ADDENDUM

Article 1 Date of Entry into Force

This Act enters into force five months after its promulgation. However, amended Article 59(1) enters into force three months after its promulgation.

**Article 2 Application for Treating the Technical Evaluation of a
Utility Model**

Amended Article 28*bis* applies to a technical evaluation of utility model filed for the first time after the enforcement of this Act.

**Article 3 Transitional Measures on the Domestic Period for
Submitting Documents for an International Utility Model Application**

Notwithstanding amended Article 59(1), the previous provisions apply to an international utility model application for which the domestic period for submitting documents expires when this Act enters into force.